

REMARKS

By this Reply, Applicants amend claims 1, 54, 63 and 72 and add new claims 73-84. Claims 1-84 are therefore pending in this application, with claims 1, 54, 63 and 72 being independent. Support for the claim amendments and new claims can be found throughout Applicants' disclosure, for example, at pages 11-12 and 38-41 and Fig. 15. No new matter has been introduced.

In the Office Action of March 23, 2007 ("Office Action"), claims 21 and 52 were rejected under 35 U.S.C. § 112, second paragraph; claims 1-4, 7, 8, 18-32, 35-43, 47-55, 57, 58, 60-64, 66-67 and 69-72 were rejected under 35 U.S.C. § 102 based on U.S. Patent No. 5,880,731 ("*Liles*"); claims 5, 6, 9-17, 56, 59, 65 and 68 were rejected under 35 U.S.C. § 103(a) based on *Liles* in view of WO 01/84461 A1 ("*Kim*"); claims 33 and 34 were rejected under 35 U.S.C. § 103(a) based on *Liles* and U.S. Patent No. 7,007,065 ("*Matsuda*"); and claims 44-46 were rejected under 35 U.S.C. § 103(a) based on *Liles* and U.S. Patent No. 7,177,811 ("*Ostermann*"). Applicants address these rejections and the new claims below.

Section 112 rejection

The Office Action asserts that claims 21 and 52 are indefinite because of the term "substantially" recited in the claims. *See* Office Action, p. 2. According to the Office Action, the term is not defined in the claim, the specification does not provide a standard, and one of ordinary skill would not be reasonably apprised of the scope of the claim. *See id.* Applicants traverse the section 112 rejection for the following reasons.

According to section 2173.02 of the M.P.E.P., "[t]he essential inquiry pertaining to this requirement [of definiteness] is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity." M.P.E.P. § 2173.05(b) states:

The fact that claim language, including terms of degree, may not be precise, does not automatically render the claim indefinite under 35 U.S.C. 112, second paragraph (internal citations omitted). Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification.

As noted in the M.P.E.P., the Federal Circuit held that “the limitation ‘which produces substantially equal E and H plane illumination patterns’ was definite because one of ordinary skill in the art would know what was meant by ‘substantially equal.’” M.P.E.P. § 21073.05(b) (quoting *Andrew Corp. v. Gabriel Electronics*, 847 F.2d 819, 6 USPQ2d 2010 (Fed. Cir. 1988)).

In this case, the recitation in claim 21 of an activity that is performed “at substantially the same time that the out-of-band message is communicated” is definite. Likewise, the recitation in claim 52 of “a depiction of the avatar in the form that is substantially similar to a trading card” is definite under section 112.

Applicants submit that one of ordinary skill in the art would be able to ascertain the meaning of “substantially the same time” and “substantially similar” from the claim language itself in light of the specification, irrespective of whether a standard or definition is explicitly stated in the specification or the claim. See M.P.E.P. § 2173.02 and § 2173.05(b). As with the recitation of “substantially equal,” one of ordinary skill in the relevant art would understand the meaning of the terms “substantially the same time” and “substantially similar.” See M.P.E.P. § 21073.05(b). Aside from a bare allegation, the Office Action offers no evidence or explanation as to why one of ordinary skill in the art would not be reasonably apprised of the scope of claims 21 and 52. See Office Action, p. 2. Applicants submit that claims 21 and 52 are fully compliant with section 112, second paragraph, and thus respectfully request withdrawal of the rejection.

Section 102 rejection

The section 102 rejection of claims 1-4, 7, 8, 18-32, 35-43, 47-55, 57, 58, 60-64, 66-67 and 69-72 should be withdrawn because *Liles* fails to anticipate these claims, as now amended. In order to properly anticipate Applicants' claims under section 102, a single prior art reference must disclose each and every element of the claim at issue, either expressly or under principles of inherency. Here, the applied reference fails to disclose each and every feature of the claims.

Claim 1 recites graphically representing, with an avatar capable of being animated, a first user in a communication session involving the first user and a second user. Claim 1 recites communicating a message between the first user and the second user, the message conveying explicit information from the first user to the second user. Claim 1 further recites receiving,

independently of the first user and the message, out-of-band information related to a context of the first user and communicating, based on stored data associations, the out-of-band information to the second user using a change in the avatar appearance or avatar animation as a communication conduit, the change being independent of a background display. The out-of-band communication differs from the information conveyed in the message sent between the first user and the second user.

Liles is directed to animating avatars. *See* Abstract. In *Liles*'s system, a user can select an avatar that will represent the user in a chat session. *Liles* discloses that the user can select an animation of the avatar that conveys a desired emotion and/or state of mind to another user in the chat session. *See* col. 3, lines 28-42. *Liles* discloses that a selected animation can be selectively displayed in combination with a textual message transmitted by the participant. *See* Office Action, p. 3; *see* col. 3, lines 32-41. *Liles* also describes that a user can select avatar animations that convey gestures (e.g., checking a watch) for display to other users in a chat session. *See* col. 7, lines 18-42; col. 9, lines 55-65.

Liles fails to disclose at least "receiving, independently of the first user and the message, out-of-band information related to a context of the first user" and "communicating, based on stored data associations, the out-of-band information to the second user using a change in the avatar appearance or avatar animation as a communication conduit, the change being independent of a background display," as recited in claim 1. While *Liles*'s system allows a user to select an avatar animation to convey an emotion or gesture (e.g., checking a watch), the reference does not disclose or suggest receiving, independently of the user and a communicated message, out-of-band information related to a context of the user. For example, *Liles* does not disclose receiving, independently of a user and a message, information indicating that a user is checking a watch. Instead, *Liles* discloses receiving a user selection of a gesture, for example, from a gesture toolbar.

Liles likewise fails to disclose communicating such out-of-band information using a change in the avatar appearance or animation, independent of a background, based on stored data associations. For example, *Liles* does not disclose any stored data associations serving as a basis for changing an avatar appearance or animation to indicate checking a watch. The reference

describes predefined gestures in script files but does not disclose or suggest any “data associations” providing a basis for changing an avatar appearance or animation to display the predefined gestures. *See* col. 9, lines 32-35.

The Office Action asserts that, in *Liles*'s system, “a participant can select and animate the avatar related to a context of the participant along with [the] text message sent between participants.” Office Action, p. 3. This assertion in the Office Action illustrates a distinction between claim 1 and the applied reference. Specifically, in the *Liles* system, any animation of an avatar to convey user context would occur, if at all, in response to a user selection of such an animation. *Liles* does not disclose receiving, independently of a user and a message, out-of-band information related to a context of a user and then communicating such out-of-band information using a change in the avatar appearance or animation, independent of a background, based on stored data associations. Indeed, in contrast to the “receiving” and “communicating” in claim 1, *Liles* merely describes allowing a user to select animations for display.

Because *Liles* fails to disclose each and every feature of claim 1, the section 102 rejection of claim 1 based on that reference should be withdrawn. The section 102 rejection of claims 1-4, 7, 8, 18-32, 35-43 and 47-53 should be withdrawn as well, since these claims depend upon claim 1 and are likewise distinguishable from *Liles*.

Independent claims 54, 63 and 72, although different in scope from claim 1 and each other, recite subject matter similar to that in claim 1 discussed above. Claim 54 recites a computer-readable medium. The medium comprises one or more code segments configured to, *inter alia*: receive, independently of the first user and the message, out-of-band information related to a context of the first user; and communicate, based on stored data associations, the out-of-band information to the second user using a change in the avatar appearance or avatar animation as a communication conduit, the change being independent of a background display. The out-of-band communication differs from the information conveyed in the message sent between the first user and the second user.

Claim 63 recites a system for communicating, the system comprising a processor connected to a storage device and one or more input/output devices. The processor is configured to, *inter alia*: receive, independently of the first user and the message, out-of-band information

related to a context of the first user; and communicate, based on stored data associations, the out-of-band information to the second user using a change in the avatar appearance or avatar animation as a communication conduit, the change being independent of a background display. The out-of-band communication differs from the information conveyed in the message sent between the first user and the second user.

Claim 72 recites a system for communicating. The system comprises, *inter alia*: means for receiving, independently of the first user and the message, out-of-band information related to a context of the first user; and means for communicating, based on stored data associations, the out-of-band information to the second user using a change in the avatar appearance or avatar animation as a communication conduit, the change being independent of a background display. The out-of-band communication differs from the information conveyed in the message sent between the first user and the second user.

Independent claims 54, 63 and 72 are distinguishable from *Liles* for at least reasons similar to those presented above in connection with claim 1. The section 102 rejection of these claims should therefore be withdrawn. The section 102 rejection of dependent claims 55, 57, 58, 60-62, 64, 66-67 and 69-71 should be withdrawn as well, since each of these claims depends upon claim 54 or 63 and is likewise distinguishable from the applied reference.

Section 103 rejection based on *Liles* and *Kim*

The section 103 rejection of claims 5, 6, 9-17, 56, 59, 65 and 68 should be withdrawn because *Liles* and *Kim* do not support a *prima facie* case of obviousness with respect to these dependent claims.

Each of claims 5, 6, 9-17, 56, 59, 65 and 68 depends upon claim 1, 54 or 63. As discussed above, *Liles* fail to disclose or suggest each and every feature of claims 1, 54 and 63. *Kim*, which was applied to certain features of dependent claims 5, 6, 9-17, 56, 59, 65 and 68, relates to changing a screen image containing an avatar acting in a virtual space and a background image. *See* Abstract. *Kim* does not cure the deficiencies of *Liles* with respect to independent claims 1, 54 and 63. *Kim* describes determining a user's location, retrieving a predefined screen image based on the location, and transmitting the screen image to a client

device for display to the user. While *Kim* describes changing a screen image containing an avatar, the reference does not disclose or suggest communicating, based on stored data associations, received out-of-band information using a change in the avatar appearance or avatar animation as a communication conduit, the change being independent of a background display, as recited in Applicants' claims.

Accordingly, *Liles* and *Kim*—whether taken alone or in any combination—fail to disclose or suggest each and every feature of claim 1, 54 or 63 or their respective dependent claims 5, 6, 9-17, 56, 59, 65 and 68. For at least this reason, *Liles* and *Kim* fail to support a case for *prima facie* obviousness with respect to claims 5, 6, 9-17, 56, 59, 65 and 68. The section 103 rejection of these dependent claims should therefore be withdrawn.

Section 103 rejection based on *Liles* and *Matsuda*

The section 103 rejection of claims 33 and 34 should be withdrawn because *Liles* and *Matsuda* do not support a *prima facie* case of obviousness with respect to these claims.

Claims 33 and 34 depend upon claim 1. As discussed above, *Liles* fail to disclose or suggest each and every feature of claim 1. *Matsuda*, which was applied to certain features of claims 33 and 34, discloses a system that converts character data constituting a chat into audio data, which is output as a voice of an avatar. See Abstract; col. 1, lines 5-12; col. 10, lines 10-12. *Matsuda* does not cure the deficiencies of *Liles* with respect to independent claim 1. Indeed, *Matsuda* fails to disclose or suggest receiving, independently of a user and a communicated message, out-of-band information related to a context of the user and communicating, based on stored data associations, the out-of-band information to the second user using a change in the avatar appearance or avatar animation as a communication conduit, the change being independent of a background display.

Accordingly, *Liles* and *Matsuda*—whether taken alone or in any combination—fail to disclose or suggest each and every feature of claim 1 or its dependent claims 33 and 34. For at least this reason, *Liles* and *Matsuda* fail to support a case for *prima facie* obviousness with respect to claims 33 and 34. The section 103 rejection of these dependent claims should therefore be withdrawn.

Section 103 rejection based on *Liles* and *Ostermann*

The section 103 rejection of claims 44-46 should be withdrawn because *Liles* and *Ostermann* do not support a *prima facie* case of obviousness with respect to these claims.

Claims 44-46 depend upon claim 1. As discussed above, *Liles* fail to disclose or suggest each and every feature of claim 1. *Ostermann*, which was applied to certain features of claims 44-46, relates to customizing multi-media messages. *See* Abstract; col. 1, lines 35-42. As noted in the Office Action, *Ostermann* describes accessorizing an animated entity, for example, with sunglasses. *See* Office Action, p. 11, *see Ostermann*: col. 11, line 60 – col. 12, line 8. *Ostermann* does not cure the deficiencies of *Liles* with respect to independent claim 1.

While *Ostermann* describes customizing a multi-media message including an animated entity, the reference does not disclose or suggest receiving, independently of a user and a communicated message, out-of-band information related to a context of the user and communicating, based on stored data associations, the out-of-band information to a second user using a change in the avatar appearance or avatar animation as a communication conduit, the change being independent of a background display. For example, *Ostermann* does not disclose or suggest receiving, independently of a user and communicated message, out-of-band information indicating that the user is in a sunny location or is wearing sunglasses and then accessorizing the animated entity with sunglasses to communicate the out-of-band information based on stored data associations.

Accordingly, *Liles* and *Ostermann*—whether taken alone or in any combination—fail to disclose or suggest each and every feature of claim 1 or its dependent claims 44-46. For at least this reason, *Liles* and *Ostermann* fail to support a case for *prima facie* obviousness with respect to claims 44-46. The section 103 rejection of these claims should therefore be withdrawn.

New claims 73-84

Each of new claims 72-84 depends upon claim 1, 54, 63 or 72 and is similarly distinguishable from the applied references. Applicants submit that the applied references further fail to disclose or suggest at least some of the additional features recited in the new dependent claims. Applicants thus request the timely allowance of new dependent claims 72-84.

Conclusion

Applicants request the Examiner's reconsideration of the application in view of the foregoing and the timely allowance of pending claims 1-84.

It is believed that all pending issues in the outstanding Office Action have been addressed by this paper. The Office Action, however, contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether or not any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action. In addition, there may be reasons for patentability of any or all pending or other claims that have not been expressed above.

If there are any questions regarding this paper or the application generally, Applicants would appreciate a telephone call to the undersigned since this may expedite prosecution of the application.

The fee in the amount of \$600.00 in payment of the excess claims fee is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please grant any extensions of time required to enter this paper and apply any other required charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

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/Frank A. Italiano/

Frank A. Italiano
Reg. No. 53,056

Customer No.: 26171

Fish & Richardson P.C.
1425 K Street, N.W.
11th Floor
Washington, DC 20005-3500
Telephone: (202) 783-5070
Facsimile: (202) 783-2331